

**DISPUTE RESOLUTION SERVICE**

**D00011286**

**Decision of Independent Expert**

The Royal Bank of Scotland Group plc

and

Mr Graham Kenny

**1. The Parties:**

Lead Complainant: The Royal Bank of Scotland Group plc  
36 St. Andrew Square  
Edinburgh  
Scotland  
EH2 2YB  
United Kingdom

Respondent: Mr Graham Kenny  
Fir Tree Cottage  
Higher Ivy Tree  
Stokeinteignhead Newton Abbot  
TQ12 4QH  
United Kingdom

**2. The Domain Name(s):**

natwest-ppi-reclaim.co.uk

**3. Procedural History:**

02 May 2012 17:11 Dispute received  
03 May 2012 10:23 Complaint validated  
03 May 2012 10:30 Notification of complaint sent to parties  
17 May 2012 10:33 Response received  
17 May 2012 10:36 Notification of response sent to parties  
22 May 2012 02:30 Reply reminder sent

24 May 2012 12:58 No reply received  
24 May 2012 12:58 Mediator appointed  
29 May 2012 10:21 Mediation started  
15 June 2012 11:02 Mediation failed  
15 June 2012 11:03 Close of mediation documents sent  
18 June 2012 10:41 Expert decision payment received

#### **4. Factual Background**

- 4.1 The Complainant is the well known bank, National Westminster Bank Plc;
- 4.2 The Respondent is an individual called Mr Graham Kenny who trades as Assured Direct;
- 4.3 The Complainant was formed in 1968 following the merger of two banks, National Provincial Bank (est.1833) and Westminster Bank (est.1836). It was incorporated into a public limited company in the UK in 1982 and acquired by the Royal Bank of Scotland Group in 2000;
- 4.4 The Complainant offers its financial services worldwide under the mark NATWEST. It has spent a significant amount of money promoting and developing this mark. It currently has 7.5million personal customers and 850,000 small business accounts;
- 4.5 The Complainant owns an international portfolio of registered trade marks which consist of or include the mark NATWEST. The Complainant also owns a large portfolio of domain names which include or consist of the mark NATWEST;
- 4.6 The Respondent runs a business providing a service to the public for claiming compensation and reclaiming premiums in respect of mis-sold payment protection insurance;
- 4.7 The Domain Name was registered by the Respondent on 10<sup>th</sup> May 2011 and is used by the Respondent to promote his business providing a service to members of the public for the claiming of compensation and reclaiming premiums in respect of mis-sold payment protection insurance by the Complainant.

#### **5. Parties' Contentions**

The Complainant contends as follows:

- 5.1 The Complainant has Rights in the name or mark NATWEST by virtue of its substantial trading history under this mark, the significant amount of money it has spent promoting and developing this mark and the large number of trade marks and domain names which it has registered around the world and which incorporates or consists of the word NATWEST;

- 5.2 The Domain Name was registered by the Respondent decades after the Complainant had registered its UK trade marks and .co.uk domain names for the name NATWEST;
- 5.3 The Complainant has a strict policy that all domain names containing the word NATWEST should be owned by the Complainant;
- 5.4 The NATWEST mark has substantial inherent and acquired distinctiveness and this is recognised across the whole Community;
- 5.5 The dominant and distinctive part of the Domain Name comprises the word NATWEST which is identical to the Complainant's registered trade mark NATWEST. The remainder of the Domain Name consists of the generic terms PPI and RECLAIM which only describe the intent behind the Respondent's website. To support its case the Complainant refers to DRS case D00005761 where the panellist found that the registration of the domain name natwest-ibank.co.uk was an Abusive Registration and that the distinctive component of that Domain Name was the name or mark NATWEST;
- 5.6 The Domain Name is confusingly similar to the Complainant's world famous trade mark NATWEST and indeed the fame of this trade mark has been confirmed in numerous decisions under both the UDRP and DRS before WIPO, NAF and Nominet;
- 5.7 Anyone who sees the Domain Name is bound to mistake it for a name related to the Complainant. The likelihood of confusion includes obvious association with the trade mark of the Complainant;
- 5.8 By using the trade mark NATWEST as a dominant part of the Domain Name, the Respondent is unfairly exploiting the goodwill and the image of the NATWEST trade mark which may result in dilution and other damage to the Complainant's trade mark;
- 5.9 Anyone seeing the Domain Name is likely to think it is in some way connected to the Complainant and therefore there will be initial interest confusion;
- 5.10 The Respondent has no legitimate rights in the name NATWEST and there is nothing to suggest that the Respondent is commonly known by the Domain Name;
- 5.11 In addition to the Domain Name, the Respondent uses the Complainant's logo on the website and the effect is to deceive the Complainant's customers into believing the website is managed by the Respondent. In other words, the Complainant's customers will access the Respondent's website perceiving it to be an official site when in fact it is not. This has an obvious detrimental effect on the Complainant's business which includes the potential loss of customers.

5.12 The Complainant has tried to contact the Respondent and has sent him a cease and desist letter on 16<sup>th</sup> June 2011. No response was received to this cease and desist letter and a reminder was sent on 27<sup>th</sup> June 2011;

In his Response the Respondent makes the following contentions:

5.13 The Respondent is entitled to the registration and to use the Domain Name and the Respondent's registration and use of the Domain Name is not an Abusive Registration;

5.14 The Respondent is providing a service to members of the public for claiming compensation and reclaiming premiums in respect of mis-sold payment protection insurance. The Respondent provides services in relation to a number of financial institutions and owns domain names/runs websites specific to each financial institution;

5.15 The Domain Name specifically refers to PPI and RECLAIM to make the nature of the Respondent's service and business perfectly clear. In all the circumstances, the Respondent is entitled to register and use the Domain Name;

5.16 The Respondent does not believe that the Royal Bank of Scotland Plc is providing a service of the same or similar nature and therefore has no proprietary rights in the Domain Name;

5.17 The Respondent is not seeking to trade or to hold himself out as trading as a bank or similar financial institution. He is simply providing a specific service which in no way competes with or undermines the trade or business of the Royal Bank of Scotland Plc. The Respondent has ensured that the Domain Name specifically refers to the nature and purpose of the registration and in so doing it avoids any such confusion amongst the general public;

5.18 The Respondent has corresponding domain names for other financial institutions including, but not limited to Lloyds TSB and Halifax. In regard to those institutions the Respondent has received similar correspondence from them, but after initial dialogue no action has been pursued and the continued registration and use of these domain names has continued uninterrupted by the Respondent. The Respondent contends that these organisations have no doubt formed the view that no issue of abuse arises and that the Respondent is fully entitled to these registrations and the use in question;

5.19 The Natwest-ibank.co.uk decision referred to by the Royal Bank of Scotland can be easily distinguished as in the present case, the use of NATWEST is specifically to identify the products in relation to which mis-selling service arises.

5.20 The Complainant has suffered no loss or damage and will not suffer any loss or damage from the continued registration and use of the Domain Name. Any business derived by the Respondent from the Domain Name is specific to claims for mis-selling of NatWest products. This is not business conducted by the Royal Bank of Scotland Plc and not a matter which the Complainant derives revenue, trade or income from.

## **6. Discussions and Findings**

6.1 Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:

- i. *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- ii. *The Domain Name, in the hands of the Respondent, is an Abusive registration.*

6.2 As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6.3 The definition of Rights in the Policy is as follows:

*Rights means rights enforceable by the Complainant whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.*

6.4 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.5 There can be no serious doubt that the Complainant has Rights in the word or mark NATWEST. The Complainant has an impressive trading history under this mark, together with a large number of registered trade marks and domain names which consist of or include the name or mark NATWEST.

6.6 The Domain Name also includes the words PPI and RECLAIM which are separated from the word NATWEST by hyphens. The question therefore is whether the Domain Name is similar or identical to the name or mark in which the Complainant has Rights, i.e. the name or mark NATWEST.

6.7 The Domain Name includes the word in which the Complainant has Rights, i.e. the name or mark NATWEST in its entirety. Further, it

seems to me that the name or mark NATWEST is also the dominant or distinctive part of the Domain Name with the words PPI and RECLAIM being more descriptive. I therefore conclude that on the balance of probabilities that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

### **Abusive Registration**

- 6.8 Abusive Registration is defined in Paragraph 1 of the Policy as a domain name which either:
- i. *Was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
  - ii. *Has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.*
- 6.9 This definition allows me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.
- 6.10 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may evidence that the Domain Name is not an Abusive Registration.
- 6.11 The Policy provides for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.
- 6.12 The Complainant's case is, inter alia, that the Respondent has registered and uses the Domain Name to take unfair advantage of the Complainant's name or mark. The Complainant says that when a member of the public sees the Domain Name they will automatically assume there is some kind of commercial relationship between the Respondent and the Complainant due to the incorporation of the Complainant's mark within the Domain Name. In other words, there will be initial interest confusion which has been consistently held by Experts under Nominet's DRS to be enough for a finding of Abusive Registration.
- 6.13 In the alternative, the Complainant says that when the public arrive on the Respondent's website, they will think that the website is either run by the Complainant or is connected with it in some way due largely to the fact that the Complainant's logo appears prominently on the website.

- 6.14 The Respondent on the other hand says that he is offering a service which is aimed at assisting the public to reclaim monies they are entitled to as a result of the mis-selling of PPI by the Complainant. He is selling a service which relates specifically to the Complainant and its use of the Complainant's mark it is therefore only using the Complainant's mark to identify its services as such. There is no suggestion that the Respondent's use of the Domain Name relates to other financial institutions. It is specifically aimed at the Complainant's activities.
- 6.15 The central question is therefore whether the Respondent is taking unfair advantage of the Complainant's Rights or is unfairly detrimental to those Rights or is he simply using the Domain Name fairly in relation to his legitimate business to indicate the nature of his services.
- 6.16 It is helpful to look at some of the previous decisions under Nominet's DRS. It seems to me that there are three broad categories of case which could be of assistance here. These are all cases where the domain name in issue included the name or mark in which the complainant had Rights and where that mark is well known. These are as follows:
1. Cases where the respondent was using the name or mark in which the complainant had Rights without addition or with only the addition of some fairly descriptive words which relate to the complainant's own business – a feature of these cases is that the respondents are usually up to no good and have registered the domain names either to divert customers to their own trading websites or use the domain names as parking pages in order to generate pay per click revenue. One such example of a case that falls into this category is DRS case D00005761 natwest-ibank.co.uk which is cited by the Complainant in its Complaint. These cases are usually relatively easy and it is clear that the domain name is being used to create an unfair advantage for the respondent and this in turn causes unfair detriment to the complainant's name or mark.
  2. Reseller cases – these are cases where the respondent operates an online shop which resells the genuine goods of the complainant. These cases are more difficult, although for a number of reasons they have generally been decided in favour of the complainants. I will discuss the relevant tests set out in these cases below;
  3. Tribute or Criticism Sites – these cases can be decided either way, but as a rule of thumb the domain names in issue stand a much better chance of being regarded as fair use if the domain name flags up what the visitor is likely to find at the site rather than use the mark without addition. This is set out in the expert's overview as follows:

*A criticism site linked to a domain name such as <ihateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant.*

6.17 Returning now to the reseller sites which I described as category 2 above, these were considered by the Appeal Panel in DRS07991 toshiba-laptop-battery.co.uk. In this case the respondent was using the domain name to run a site which sold both Toshiba laptop batteries, other Toshiba accessories as well as other accessories from other manufacturers. The Appeal Panel summarised the principles to be applied as follows:

1. *It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case;*
2. *A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant;*
3. *Such an implication may be as a result of "initial interest confusion" and is not dictated only by the contents of the website;*
4. *Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name was unfair. One such reason is the offering of competitive goods on the respondent's website".*

6.18 The present case does not fit squarely into any of these categories although it has some similarities with all three, particularly, in my view, the reseller cases.

6.19 From the Toshiba laptop battery case, it can be seen that the test is really whether the respondent's use of the domain name is such so as to falsely to imply a commercial connection with the complainant. This implication can be drawn because of, "initial interest confusion", i.e. because the public see the domain name and assume it is connected with the complainant, or it can be for another reason – for example because the public visit the website and assume it is something to do with the complainant.

6.20 The Respondent says that his registration and use cannot be an Abusive Registration because, inter alia, the Complainant does not provide the same services and therefore the Complainant's mark is only used to identify the nature of the services that the Respondent is providing. I am not sure whether what the Respondent says is



completely correct as a matter of fact. Neither side has provided any evidence about it, but I am aware that claims for PPI mis-selling can be made directly to the institutions involved as well as through claims handling services, such as the one run by the Respondent and indeed there has been quite a lot about this in the press in the last few months.

- 6.21 In any event and whether or not what the Respondent says about the Complainant offering these services is correct it seems to me to be entirely feasible that a member of the public who is looking to reclaim their premiums or make a claim in relation to mis-sold PPI may well visit the Respondent's website believing it is in some way connected to the Complainant and that it therefore provides a way of claiming or reclaiming these monies directly from the Complainant.
- 6.22 One could argue that this is only analogous with the tribute or criticism site point and that the Domain Name is simply flagging up what one can expect to find at the Respondent's website. I do not think however that this analogy holds good. With the tribute or criticism sites, if you go to a site which is linked to the domain names, "IhateNatWest.co.uk" or "IloveNatWest.co.uk", you know what you are going to get, i.e. a site either criticising or praising NatWest. It is very unlikely to be run by NatWest. The Domain Name is however subtly different. It is suggestive of a service that the Complainant may well feasibly offer (even if in actual fact it does not) as it is so closely related to the Complainant's business. In my view and on the balance of probabilities this makes it all the more likely that the public will believe that the Domain Name is something to do with the Complainant, regardless of the fact that the Domain Name describes what is to be found at the site.
- 6.23 I am also swayed towards this view by the look and feel of the Respondent's site. The Complainant's logo appears prominently at the top of the Respondent's site and the true identity of the Respondent is only contained in very small type at the bottom of the site. It seems to me that it is very possible indeed that the public will believe that the site is indeed something to do with the Complainant. It may even be that this is the Respondent's intention.
- 6.24 By way of conclusion therefore I do think that on the balance of probabilities that the Respondent has registered and/or used the Domain Name in order to take unfair advantage of the Rights that the Complainant has in its name or mark and that in doing so, it may well have also caused unfair detriment to those Rights. I therefore find that on the balance of probabilities that the Domain Name is in the hands of the Respondent an Abusive Registration.

## **7. Decision**

I find that, on the balance of probabilities, the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the

Domain Name is in the hands of the Respondent an Abusive Registration. I therefore direct that the Domain Name be transferred to the Complainant.

**Signed Nick Phillips**

**Dated 19 July 2012**